



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,013	07/03/2001	Ariel Peled	01/22083	9188

7590
Martin D. Moynihan
PRTSI, Inc.
P.O. Box 16446
Arlington, VA 22215

10/10/2007

EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
----------	--------------

2134

MAIL DATE	DELIVERY MODE
-----------	---------------

10/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/897,013

Applicant(s)

PELED ET AL.

Examiner

David Y. Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1, 5, 6, 10, 14, 19, 22, 24 and 35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

Continuation of Disposition of Claims: Claims pending in the application are 1,5,6,10,14,19,22,24,35 and other uncanceled but withdrawn claims.

Art Unit: 2134

DETAILED ACTION

CLAIMS PRESENTED

Claims 1,5,6,10,14,19,22,24,35 are presented.

FILE HISTORY

Because of the extremely complex situation involving the previous examiner and the previous attorney (inter alia, such as the disbarment of the previous attorney), the current examiner defers to the previous Office Actions and the previous Office communications for discussion on many of the issues. Unless actually contradicted by the current examiner, the previous discussion in the file history is hereby given full weight.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding claims 1,5,6,10,14,19,22,24,35, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (digital file, network, computer readable medium, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an

Art Unit: 2134

electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance.

For further guidance on the term “nonfunctional”, please see MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,5,6,10,14,19,22,24,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown

(http://archive.salon.com/tech/feature/2001/03/27/media_tracker/index.html., page 1).

Regarding claim 1, Brown teaches all but “digital file” (the second paragraph, keeping track of who and what is being downloaded using peer-to-peer networks).”

Art Unit: 2134

These passages of Brown do not teach "digital" in the sense of the claim. In the sense of the claim (as inferred from the specification), the term "digital file" seems to refer to the nature of being uploadable as well as being downloadable.

Nevertheless, it was well known in the art to have such a "digital file" situation among peer-to-peer distribution for the motivation of facilitating peer-to-peer distribution.

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Brown for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claim 5 (operation of search features, etc.), such particular features are well known in the art for the purpose of efficiently (because of use of the same search feature) handling information across computers.

Regarding claims 6, 10, 14 (signature, etc.), such particular features are well known in the art for the purpose of identifying information across computers.

Regarding claim 19 (title, etc.), such particular features are well known in the art for the purpose of efficiently (because title is the easiest to text search) identifying information across computers.

Regarding claim 22, 24, 35 (signature, etc.), such particular features are well known in the art for the purpose of identifying information across computers.

Conclusion

Art Unit: 2134

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Kambiz Zand whose telephone number is (272) 272-3811.

Art Unit: 2134

David Jung

A handwritten signature in black ink, consisting of a large loop followed by a series of connected, wavy lines extending to the right.

Patent Examiner

10/1/07